

## **REMARKS/ARGUMENTS**

The Applicant thanks the Examiner for the Office Action dated July 5, 2005.

The Office Action has been carefully considered. It is respectfully submitted that the issues raised are traversed, being hereinafter addressed with reference to the relevant headings appearing in the Detailed Action section of the Office Action.

### ***Claim Rejections – 35 USC § 112***

On page 2 of the Office Action, the Examiner has rejected claims 9, 11-13, 22-25 and 27. Furthermore, the Examiner has stated "*Claim 28 is improper for the reasons given above*".

However, we believe that the Examiner has incorrectly applied 35 USC 112 5<sup>th</sup> paragraph, which states:

*"A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed..."*

Thus, for example, claim 9 states "*The method according to any one of claims 1, 4, 5 or 6...*". Although claim 9 is a multiple dependent claim, it is only dependent in the alternative form by stating "*according to any one of claims 1, 4, 5 or 6*" and is only dependent from other claims which are not multiply dependent claims. Thus, claim 9 is a valid multiple dependent claim under 35 USC 112 5<sup>th</sup> paragraph.

Furthermore, although claims 11-13, 22-25 and 27 are also multiple dependent claims, these claims are only dependent on claims which are not multiply dependent. Additionally, claim 28 is only dependent on claims which are not multiply dependent.

The only reason a multiply dependent claim can be rejected under 35 USC 112 5<sup>th</sup> paragraph is:

*"A multiple dependent claim shall not serve as a basis for any other multiple dependent claim."*

None of claims 9, 11-13, 22-25, 27 and 28 have served as a basis for any other multiple dependent claims (ie. claim 11 is not dependent on claim 11) and thus these claims cannot be rejected under 35 USC 112 5<sup>th</sup> paragraph.

As such we respectfully request that the Examiner withdraw the rejection.

If the Examiner maintains this rejection, we would appreciate clarification from the Examiner regarding how the above-mentioned claims can be rejected under 35 USC 112 5<sup>th</sup> paragraph when the claims which they depend from are not multiply dependent claims.

### ***Claim Rejections – 35 USC § 102***

At page 3 of the Office Action, the Examiner rejects claims 1 to 12, 14 to 17 and 19 to 27 as being anticipated by Lemelson (US Patent No. 4,681,548).

Reconsideration and withdrawal of this rejection is respectfully requested in light of the following comments.

Claim 1 was amended in the previous response dated 28 February to recite in the preamble that:

"..., at least some of the coded data being coincident with the visible information."

However, the justification provided by the Examiner in regard to claim 1 on page 3 of the Office Action fails to consider this integer of the claim. We are unsure whether the Examiner has overlooked this amendment to the claim, or whether the Examiner has refused to consider the amendment.

We highlight MPEP §704.14(b) *"Examiner's Obligation Following Applicant's Reply [R-2]"* which states:

*"The examiner must consider the information submitted with the applicant's reply and apply the information as the examiner deems appropriate. This obligation arises from the examiner's assertion that the information is necessary to the examination in making the requirement."*

As pointed out on page 10 of the previous response, Lemelson fails to teach or suggest that at least some of the coded data is coincident with the visual information. Lemelson only teaches coded data in the form of a magnetic strip which is clearly provided separate of all visual information. This feature of the visual information and at least some of the coded data being coincident allows the sensing device to be placed in an operative position relative to related visual information and sense at least some of the coded data.

If the Examiner has overlooked this amendment, we respectfully request that the Examiner expeditiously allow the application as the rejection under 35 USC § 102 has been incorrectly maintained.

However, if the Examiner has refused to consider the amendment to the preamble, we highlight to the Examiner MPEP §2111.02 *"Effect of Preamble [R-2]"* which states:

*"If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999).*

...  
*Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989)"*

Clearly, by providing at least some of the coded data coincidently with the visual information, a user can operative use a sensing device such as to select the related coded data. Thus, only a portion of the coded data on the document may need to be sensed and not the entire coded data on the document. Furthermore, the user can selectively sense the relevant coded data due to this limitation without the user actually intending to read the coded data relevant to the visual information.

The fact that numerous advantages have been outlined above regarding the coincident relationship between the visual information and at least some of the coded data indicates that the claim preamble gives *'...necessary life, meaning, and vitality to the claim'*, and as such

the claim preamble should be construed as if in the balance of the claim, as stated by MPEP §2111.02.

Furthermore, we note that on page 2 of the Office Action, the Examiner has highlighted lines 5 to 10 of column 6 as showing "*requesting a copy of a page of the document*". However, lines 5 to 10 has absolutely no relevance to requesting a copy of the document. Lines 5 to 10 of column 6 state:

*"...synthetic speech signal generator, as in step 39S; a display driver, as in step 39U or a printer driver, as in step 39W to effect the respective functions defined in steps 39T, 39V and 39X of generating selected sounds of select words of speech, displaying a score or instruction, a move, a command or providing an answer to a..."*

Nothing in this highlighted section of Lemelson discloses requesting a copy of a document and thus the highlighted section is totally irrelevant. The fact that the highlighted section of Lemelson discloses a printer driver still fails to disclose all integers of the claim to maintain a 35 USC § 102 rejection as there is no reference to making a copy of any sort of document.

Additionally, why would the device disclosed by Lemelson need to make a copy of the document? Clearly, as noted at lines 11 the printer can be used to provide "*a print out of data such as a score*", but this is irrelevant to printing a "copy" of the document. There is absolutely no reference in Lemelson that the device disclosed could be used to make a copy of the document which is sensed. Furthermore the memory disclosed by Lemelson does not contain data to produce a copy of the card, and the device does not include any copying mechanism such as a photocopier to copy the card. As such the Examiner should withdraw the rejection under 35 USC § 102 based on Lemelson.

Reconsideration and withdrawal of the rejection is respectfully requested.

#### ***Claim Rejections – 35 USC § 103***

The Examiner has rejected claims 13, 18, 21 and 28 as being unpatentable over Lemelson in view of the Well Known Prior Art 2144.03.

However, the MPEP states at §2143 "*Basic Requirements of a Prima Facie Case of Obviousness*" that:

*"... three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. **Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.**"*

Claims 13, 20 and 28 are dependent on independent claims 1, 19 and 14 respectively. Claims 1, 14 and 19 specify that at least some of the coded data is coincident with the visual information and that the method and system makes a copy of the document which the coded data is sensed from. As noted under the response to the 35 USC § 102, Lemelson fails to teach or suggest these features. Furthermore, the Examiner has not suggested that these features are well known in the art.

As such, the Examiner has failed to meet at least the third basic requirement of a prima facie case of obviousness in that the prior art reference (or references when combined) fail to teach or suggest all the claim limitations.

Reconsideration and withdrawal of the rejection is respectfully requested.

In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §122, 35 U.S.C. §102(b) and 35 U.S.C. §103(a). The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.


Very respectfully,

Applicants:



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